

REMARKS/ARGUMENTS

Favorable reconsideration of this application in light of the following discussion is respectfully requested.

Claims 24-25, 28-34 and 36-74 are presently active in this case. The present Amendment amends Claims 24-25, 29-31, 36, 38, 43, 48-50, 55, 58, 60, 66-67, and 69; cancels Claims 26-27 and 35; and adds Claims 70-74.

The outstanding Office Action rejected Claims 43 and 44 under 35 U.S.C. § 102(b) as anticipated by Laguionie (U.S. Patent No. 1,833,293). Claims 66, 68, and 69 are rejected under 35 U.S.C. § 102(b) as anticipated by French Patent '805. Claims 24, 25, 28-34, 36-41 were rejected under 35 U.S.C. § 103(a) as unpatentable over Petroczky (U.S. Patent No. 3,669,130) in view of Koppel (U.S. Patent No. 5,318,051). Claims 24-35, 42, 47-51, 60, 61, and 67 were rejected under 35 U.S.C. § 103(a) as unpatentable over French Patent '805 in view of DE '273. Claims 45, 46, and 52-54 were rejected under 35 U.S.C. § 103(a) as unpatentable over French Patent No. '805 in view of DE '273, further in view of Montgomery (U.S. Patent No. 3,763,870). Claims 55-59, and 62-65 were rejected under 35 U.S.C. § 103(a) as unpatentable over French Patent '805 in view of DE '273 further in view of Miraglia (U.S. Patent No. 5,709,230).

Initially, Applicant respectfully requests *that the references cited in the Information Disclosure Statements filed January 17, 2006 and January 3, 2006 be acknowledged as having been considered in the next Office Action.*

In order to clarify Applicant's invention, the independent claims (which did not already recite this limitation) are amended to recite that the two parts are joined together pivotably by a film hinge. This feature finds non-limiting support in the disclosure as originally filed, for example at page 7, lines 15-18. In order to vary the scope of protection recited in the claims, new Claims 70-74 are added. New Claims 70-74 find non-limiting

support in the disclosure as originally filed, for example at page 8, lines 10-28 with corresponding Figs. 3 and 5. Therefore, the changes to the claims are not believed to raise a question of new matter.<sup>1</sup>

In response to the rejections of the claims under 35 U.S.C. § 102(b) and 35 U.S.C. §103(a), Applicant respectfully requests reconsideration of these rejections and traverses the rejections, as discussed next.

As noted above, each of the independent claims now recites that the two parts are joined together pivotably by a film hinge. The only reference cited by the Office Action for this feature is the Koppel patent. In particular, the Office Action rejected independent Claims 25 and 36, which already recited this feature, over Petroczky in view of Koppel.<sup>2</sup> Thus, all other rejections are believed to be moot and overcome by the present amendment. Applicant respectfully traverses the obviousness rejection based on the Petroczky and Koppel patents because there is no apparent reason to modify the Petroczky comb by incorporating Koppel's fold, as discussed next.<sup>3</sup>

The Petroczky patent discloses combs of the type employed for combing and arranging hair. More particularly, the Petroczky combs "are designed to achieve effective back-combing, teasing, or roughing of hair and, also to smooth or straighten tangled hair."<sup>4</sup>

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<sup>1</sup> See MPEP 2163.06 stating that "information contained in any one of the specification, claims or drawings of the application as filed may be added to any other part of the application without introducing new matter."

<sup>2</sup> The Office Action rejected independent Claims 25 over French Patent '805 in view of DE '273. However, this is believed to be a typographical error because the rejection does not address at all the film hinge limitation.

<sup>3</sup> See MPEP 2143.01 stating "[o]bviousness can only be established by combining or modifying the teaching of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art," (citations omitted). See also MPEP 2144.08 III stating that "[e]xplicit findings on motivation or suggestion to select the claimed invention should also be articulated in order to support a 35 U.S.C. 103 ground of rejection. . . Conclusory statements of similarity or motivation, without any articulated rational or evidentiary support, do not constitute sufficient factual findings."

<sup>4</sup> The Petroczky patent at column 1, lines 3-7.

The Petroczky patent states that such combs "may be formed in any suitable manner such as by **molding** or casting **in one piece.**"<sup>5</sup> The Petroczky comb 20 includes a main body 22, two end tines 24 and 26, a handle 28, and two sets of identical curved teeth 30 and 32.

In contrast, the Koppel patent discloses a comb that is significantly different from such "conventional" combs. In particular, the Koppel patent states that its comb is not compatible with conventional molding techniques and is not for normal grooming:

When forming a conventional comb, such as those used in normal grooming of human hair, **it is conventional to mold** the entire comb **in a single piece** from some relatively hard material such as plastic or metal. With sizable gaps between teeth of a conventional comb, it is possible to use a conventional mold for the entire comb and quickly and efficiently mass-produce them.

However, certain specialty combs have structural and manufacturing requirements that **make it impossible to use a conventional molding procedure for manufacture.** One type of these specialty combs is the **fine tooth comb** used in the removal of lice from hair. The head louse is an external parasite known to occasionally infest the hair of a mammal, including humans. Removal of adult lice from hair can be a routine procedure requiring perhaps only a washing of the infested hair with special shampoo. However, these parasites glue their eggs, or "nits," directly to individual shafts of hair, making their removal more difficult.<sup>6</sup>

The Koppel patent thus teaches to form a lice-removing fine tooth comb by folding two half-comb blanks along a fold 36. Each half of the comb includes every other tooth of the full comb, such that when the two halves are mated, the two sets of teeth will be interleaved to form a comb having narrow inter-tooth gaps. "**This allows** each of the half-comb blanks to be directly stamped from a sheet material as a practical matter, **since the spacing between the teeth of the half-comb is much greater than the inter-tooth gaps of the completed comb.**"<sup>7</sup>

Therefore, a person skilled in the art, reading the Petroczky and Koppel patents, would have no apparent reason to modify the Petroczky comb by incorporating Koppel's fold.

<sup>5</sup> The Petroczky patent at column 1, lines 70-71 (emphasis added).

<sup>6</sup> The Koppel patent at column 1, lines 12-38 (emphasis added).

<sup>7</sup> The Koppel patent at column 2, lines 15-29 (emphasis added).

The Koppel fold is used in order to allow the manufacture of a fine tooth comb configured to remove lice. Specifically, the *fold* of the Koppel fine tooth comb (identified in the Office Action as corresponding to the claimed hinge) allows the half-comb blanks to be conveniently stamped with a spacing between the teeth that is much greater than the inter-tooth gaps of the completed comb. By contrast, the Petroczky comb is not a fine tooth comb, as it is used not for removing lice, but for back-combing, teasing, or roughing of hair. Such a comb need not, and should not, be manufactured with a short spacing between consecutive teeth. If the Petroczky comb were to be modified to be a fine tooth comb, it would no longer serve its intended purpose. Thus, there is no apparent reason to complicate the making of the Petroczky comb by requiring the folding of two half-comb blanks. Further, the Petroczky patent states that its comb can simply be made by molding in one piece, while the Koppel patent states that its fine-tooth comb is not compatible with conventional molding techniques.

The Petroczky and Koppel patents, therefore, do not provide the motivation to perform the proposed modification of the Petroczky comb. In other words, an attempt to bring in the isolated teaching of Koppel's fold into the Petroczky comb would amount to improperly picking and choosing features from different references *without regard to the teachings of the references as a whole.*<sup>8</sup>

Further, it is not clear how the combination of the Petroczky and Koppel patents meets the limitation of independent Claim 36, which requires that the arrangement of teeth includes at least two parts along an axis, that the two parts be joined together pivotably by a film hinge, and that the film hinge be oriented *at a right angle* to the axis.

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<sup>8</sup> See In re Ehrreich 590 F2d 902, 200 USPQ 504 (CCPA, 1979) (stating that patentability must be addressed "in terms of what would have been obvious to one of ordinary skill in the art at the time the invention was made in view of the sum of all the relevant teachings in the art, not in view of first one and then another of the isolated teachings in the art," and that one "must consider the entirety of the disclosure made by the references, and avoid combining them indiscriminately.")

Applicant further traverses the reliance on *In re Leshin* as establishing a per se rule that the selection of a known material is obvious. The Office Action does not establish that the claimed materials are known. Further, the Office Action does not compare the facts in *In re Leshin* with those in the present case and explain why, based upon this comparison, the legal conclusion in the present case should be the same as that in *In re Leshin*. For a *prima facie* case of obviousness to be established, the teachings from the prior art itself must appear to have suggested the claimed subject matter to one of ordinary skill in the art. The Office Action should explain why the prior art would have suggested to one of ordinary skill in the art the desirability of the modification.

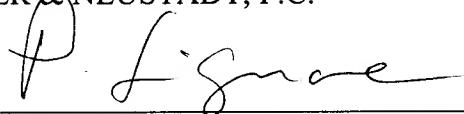
Also, it is not clear how the prior art meets a number of limitations recited in the dependent claims, in combination with the features of the independent claims. For example, the features of Claims 33, 38, 40-41, 45-47, 48-54, 56, 59, 61, 64, 70-74 are not identified in the Office Action.

Consequently, in view of the present amendment, no further issues are believed to be outstanding in the present application, and the present application is believed to be in condition for formal Allowance. A Notice of Allowance for Claims 24-25, 28-34 and 36-74 is earnestly solicited.

Should the Examiner deem that any further action is necessary to place this application in even better form for allowance, the Examiner is encouraged to contact Applicant's undersigned representative at the below listed telephone number.

Respectfully submitted,

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